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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,592	07/08/2003	Louis Johan Wagenaar	BAY-001.01	8286

25181 7590 08/01/2008  
FOLEY HOAG, LLP  
PATENT GROUP, WORLD TRADE CENTER WEST  
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BOSTON, MA 02110

EXAMINER
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AZPURU, CARLOS A

ART UNIT	PAPER NUMBER
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1615

MAIL DATE	DELIVERY MODE
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08/01/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/615,592	<b>Applicant(s)</b> WAGENAAR, LOUIS JOHAN	
	<b>Examiner</b> Carlos A. Azpuru	<b>Art Unit</b> 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 3, 18, 20-24, 36-40, 43-45, 47-52 and 54-72 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 3, 18, 20-23, 36-40, 43-45, 47-51, 54-58, 60-66 and 68-71 is/are rejected.
- 7) ☒ Claim(s) 23, 52, 59, 67 and 72 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                            |                                                                                         |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

Receipt is acknowledged of the amendment filed 03/06/2008.

The rejection of the claims under 35 USC 102(b) over the tradename Siccaprotect is hereby withdrawn.

The following is a new rejection of the claims:

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 18, 20-22, 24, 36-40, 43-45, 47-51, 54-58, 60-66, 68-71, are rejected under 35 U.S.C. 103(a) as being unpatentable over Siccaprotect in view of WO 98/32421 (WO'421) (reference AK on PTOL-1449 filed 03/23/2006) .

Siccaprotect™ is disclosed as containing dexpanthenol and is used in eye drops compositions for contact lenses (see D1-D4). The composition appears to also contain polyvinyl alcohol and benzalkonium chloride as a preservative used against gram-positive and gram-negative bacteria (see D1 and D2). The percentage of dexpanthenol is higher than 1% (see newly cited Siccaprotect material from UesaPharm). Tradename

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information does not address the issue of the kind of contact lens to be disinfected, or the demulcents such as HPC or HPMC.

However, whether the contact lens is soft, hard , daily or extended, there is no reason why one of ordinary skill would not expect beneficial results from the use of dexpanthenol on any lens product. Barring a showing of unexpected and/or unusual results, the use of dexpanthenol would be expected to provide similar preservative results on any lens.

While the Siccprotect trade papers do not address the use of demulcents other than polyvinyl alcohol, WO'421 discloses the use of any number of demulcents which are considered equivalents to polyvinyl alcohol for use in eye drops (see page 1, third paragraph, HPC, HPMC and polyvinyl pyrrolidone are specifically recited. It should be noted that NaCl and EDTA are also recited for use in such compositions at page 7, Example II., Therefore, it would have been well within the skill of the ordinary practitioner to use any number of demulcents commonly used in lens care products such as HPC, HPMC, PVP or PVA with a reasonable expectation of beneficial results.

As such, the instant claims would have been obvious to one of ordinary skill in the art at the time of invention given the teachings of Siccprotect in view of WO'421.

Claims 23, 52, 59, 67 and 72 are objected to as dependent upon a rejected base claim.

WO 02/055118 (reference AC on 1449 dated 12/28/2004) is cited for its teaching that dexpanthenol is effective in treating all contact lens forms (see page 5, paragraph 2).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos A. Azpuru whose telephone number is (571) 272-0588. The examiner can normally be reached on Tu-Fri, 6:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on (571) 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Carlos A. Azpuru/  
Primary Examiner, Art Unit 1615

Carlos A. Azpuru  
Primary Examiner  
Art Unit 1615

caz